

present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better condition for appeal.

In view of the following remarks Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-9 under 35 U.S.C. §103(a) as being obvious over Buell, USP 3,309,363 (hereinafter referred to as Buell '363) in view of Deguchi et al., USP 5,395,742 (hereinafter referred to as Deguchi '742). The Examiner has additionally rejected claims 1-9 under 35 U.S.C. §103(a) as being obvious over Crounse et al., USP 3,193,548 (hereinafter referred to as Crounse '548) in view of Deguchi '742). Applicants respectfully traverse each of the above rejections.

Applicants respectfully submit that the Examiner's rejections amount to hindsight reconstruction and are therefore improper within the scope of 35 U.S.C. §103(a). It is evident that the Examiner has utilized hindsight reconstruction when the cited references are reviewed in comparison to the present claims.

The Buell '363 reference discloses a diaminostilbene compound bearing two identical dihydroxypropylamino groups on the triazine ring. This double substitution is disclosed by Buell at columns 5

and 6 as being important since triazine rings with different substituents result in a loss of strength in resin-cationic softener applications. The secondary reference of Deguchi '742 discloses, among numerous others, a sulfoethylamino group and a hydroxyalkylamino group on the triazine ring. However, neither of these groups satisfy the presently claimed subject matter. Accordingly, the Examiner asserts it would have been obvious to substitute one of the dihydroxypropylamino substituents of Buell '363 with one of the sulfoethylamino groups of Deguchi '742.

However, as noted above, the sulfoethylamino group utilized by the Examiner from the secondary reference of Deguchi '742 is not the only substituent disclosed by Deguchi '742. In fact, the sulfoethylamino group is simply one of a large number of substituents disclosed by Deguchi '742. Regardless, the Examiner provides absolutely no foundation for the motivation to select this single substituent out of the myriad of substituents disclosed by Deguchi '742. This amounts to a classic misapplication of 35 U.S.C. §103(a). The Examiner's attention is directed to *In re Baird*, 29 USPQ2d 1550 (Fed. Cir. 1994), wherein the Federal Circuit found it impermissible to utilize the description of a large genus to render obvious a small number of species generically encompassed by the genus, absent some motivation or direction to select the claimed species. However, this is exactly what the Examiner is attempting to accomplish by way of the present rejection.

If the Examiner's rejection were correct, one of ordinary skill in the art would remove one of the dihydroxypropylamino groups (which are required by Buell '363 to be in pairs to retain functionality) and replace this dihydroxypropylamino group with a single group selected from a large genus of groups disclosed by Deguchi '742. Moreover, one of ordinary skill in the art would make this substitution without any direction by the secondary reference as to why the specific sulfoethylamino group of Deguchi '742 would be preferable to the large number of groups additionally disclosed by Deguchi '742. Of course, the only explanation for one of ordinary skill in the art making such a substitution would be that that person was utilizing the disclosure of the present application. Accordingly, this rejection is improper and should be withdrawn.

Regarding the Examiner's second rejection utilizing Crounse '548 in view of Deguchi '742, Applicants respectfully submit that the Examiner has again failed to observe the correct procedures for preparing a *prima facie* case of obviousness. That is, the Examiner has utilized hindsight reconstruction and methods in violation of In re Baird (discussed above) in order to prepare the rejection. Accordingly, this rejection is also improper and should be withdrawn.

As discussed above, the Examiner has failed to prevent a valid *prima facie* case of obviousness. Accordingly, each of the outstanding rejections should be withdrawn. However, even if the

Examiner has hypothetically prepared a *prima facie* case of obviousness, such a *prima facie* case of obviousness is rebutted by the unexpected properties according to the present invention compared to the cited art. At the interview conducted on September 3, 2002, the Examiner indicated that if testing with respect to the compound of Buell '363 was conducted and compared with compounds of the present invention, he would consider withdrawing the rejection.

Applicants have prepared a Declaration pursuant to 37 C.F.R. §1.132. The Declaration outlines an experiment which compares the solubility of the compound of Buell '363 with the compounds of the present invention. The comparison test was conducted in a manner consistent with the method described in the present specification at page 27, line 32 to page 28, line 10, namely, example 7. A review of the Declaration reveals that the compound according to Buell '363 does not dissolve in water after a mixture of the compound and the water is stirred for a period of 300 seconds at 40°C. No dissolution test was conducted at 0°C, since the results of the dissolution test at 40°C indicate that no such test is necessary. Accordingly, the prior art fails as a whole to recognize that the currently claimed diaminostilbene derivatives may be favorably employed in an aqueous fluorescent brightening solution. In contrast, the most relevant primary reference of Buell '363 is not soluble in water even at 40°C. These results are superior and unexpected in view of the prior art. Accordingly, any hypothetical

prima facie case of obviousness has been rebutted. Reconsideration and withdrawal of these rejections is respectfully requested.


If the Examiner has any questions or comments, please do not hesitate to contact Craig A. McRobbie, Registration No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Pursuant to 37 C.F.R. § 1.17 and 1.136(a), Applicants respectfully petition a three (3) month extension of time for filing a response in connection with the present application. The required fee of \$920.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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